

Appl. No. 10/065,523
Reply to Office action of March 31, 2005

REMARKS

Claims 1-35 were pending in the application. Applicants note with appreciation the Examiner's willingness to allow Claims 3, 4, 9, 10, 18 and 19 if rewritten in independent form. However, in view of the following remarks, Applicants have not placed these claims in independent form. Reconsideration of the amended claims, in view of the following remarks, is respectfully requested.

In the Office Action, the following actions were taken or matters were raised.

Rejection of Claims under 35 U.S.C. 103(a)

Claims 1, 2, 5-8, 11-13, 16, 17, 20-26, and 29-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Gipson* (U.S. 5,839,514) in view of *Gudgel* (U.S. 4,291,762). Of the rejected claims, Claims 1, 8, 17 and 29 are independent.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaack*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143.

Applicants respectfully submit that the proposed combination of references does not disclose, teach or suggest all claim limitations of independent Claims 1, 8, 17 and 29. The examiner is relying on *Gudgel* for the proposition that "*Gudgel* discloses a method and apparatus for positioning oilfield equipment that involves the use of two telescoping load-bearing arms (Figure 1)." (Office Action, Page 2) (Emphasis added). However, *Gudgel* discloses only that "[t]he inside blowout preventer is suspended on the cable harness 74 balanced by a counterweight" (*Gudgel*, Col. 6, Lines 61-64). *Gudgel* appears to further disclose that "[t]he elevation may be easily adjusted up and down since the counterweight is selected so as to balance the weight of the entire assembly, including the blowout sub 16." (*Gudgel*, Col. 6, Line 68 – Col. 7, Line 3). Accordingly and contrary to the examiner's conclusions, *Gudgel* does not disclose or suggest "two telescoping load bearing arms" as originally recited by independent Claim 1 since the oilfield apparatus is clearly supported and balanced by cable harness 74, and not the telescoping segments. (Emphasis added). Therefore, for at least these reasons, Applicants submit that the rejection of claims 1, 8, 17 and 29 are in error for at least this reason.

Claims 1, 8, and 17 have been amended to make clear that the lifting is accomplished through the action of extending the telescoping arms. Neither *Gipson* nor *Gudgel* suggest this. As explained above, *Gudgel* lifts the blowout preventer through use of cables, not through the action of extending telescoping

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arms. Therefore, Claims 1, 8 and 17 are also patentable over the combination of *Gipson* and *Gudgel* for at least this reason.

Claim 29 has been amended by incorporating limitations from claims 30 and 31, and deleting limitations added to claim 33. The examiner admits that the limitations in claim 31 are not found in *Gipson* or *Gudgel*, but concludes that they would have been obvious nonetheless, citing only applicants' own teachings. Compare to paragraph [0035] of the specification. The rejection of claim 31 (as well as claims 5, 6, 11, 18, 22 and 23) is plainly an impermissible exercise of hindsight, which cannot support a *prima facie* case of obviousness. It is submitted that claim 29 is allowable for this reason in addition to the reasons mentioned above.

Claims 2-7, 9-16, 18-28 and 33-35 depend respectively from independent Claims 1, 8, 17 and 29, and therefore are allowable for at least this reason. Given their dependence on allowable base claims, Applicants have chosen not to address the rejections of some of the claims, but do reserve the right to address the errors in the rejections at subsequent time and on appeal.

Newly Added Claims

Applicants have added claims 36-44. Applicants respectfully submit that Claims 36-44 are patentable over the prior art for at least the following reasons. In the case of claims 36-39, the art of record does not suggest use of a transport mechanism disposed on and movable along a cross-support member between two telescoping arms, as claimed. In the case of claims 40-44, the art of record does not suggest use of both a transport mechanism and a mounting, as claimed.

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CONCLUSION

Please charge Deposit Account No. 13-4900 of Munsch Hardt Kopf & Harr, P.C. in the amount of \$750.00 for additional claim fees.

In addition, a Petition for Extension of Time is attached. Please charge the extension fee of \$120.00 to Deposit Account 13-4900.

It is submitted that the application is in condition to be allowed, and such action is respectfully requested. The Commissioner is hereby authorized to charge any fees or credit any overpayments associated with this communication to Deposit Account No. 13-4900 of Munsch Hardt Kopf & Harr, P.C.

Respectfully submitted,

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Aug. 1, 2005

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